

Title: CONTAINER FOR DISCARDED SMOKING MATERIALS

Serial Number: 10/602,811

Attorney Docket No.: 2442.001

**REMARKS**

1. The finality of the Office Action dated January 5, 2006 should be withdrawn.

The Office Action dated July 27, 2005 indicated Claims 2, 5, 7,8,10, 11 and 12 to be allowable. In response to the July Office Action, independent Claim 1 was amended to include the limitations of Claim 2, and Claim 2 was canceled. Claims 3-12 depend, directly or indirectly, from allowed amended Claim 1.

The Office Action of January 5, 2006 rejects previously allowed amended Claim 1, as well as Claims 3-10. The basis for the rejection is 35 USC 103(a), citing *Garland*, U.S. Patent No. 5,765,339 in view of *LaFleur*, U.S. Patent No. 5,794,670. These references, and therefore this ground for rejection, are introduced for the first time in the Office Action of January 5, 2006.

From M.P.E.P Section 706.07:

Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection. Switching from..... one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will...tend to defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection.

.....

Title: CONTAINER FOR DISCARDED SMOKING MATERIALS

Serial Number: 10/602,811

Attorney Docket No.: 2442.001

The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application.

.....

The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal.

It is respectfully submitted that the Office Action of January 5, 2006 represents switching from "one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter", and that finality of the Office Action "defeat(s) attaining the goal of reaching a clearly defined issue."

The Applicant requests that the finality of the Office Action of January 5, 2006 be withdrawn so that the Applicant may fully address the rejection of the claims over *Garland*, in view of *LaFleur*, and the Examiner may fully respond.

The Examiner's attention is also called to:

#### 706.04 Rejection of Previously Allowed Claims

A claim noted as allowable shall thereafter be rejected only after the proposed rejection has been submitted to the primary examiner for consideration of all the facts and approval of the proposed action.

Great care should be exercised in authorizing such a rejection. See *Ex parte Grier*, 1923 C.D. 27, 309 O.G. 223 (Comm'r Pat. 1923); *Ex parte Hay*, 1909 C.D. 18, 139 O.G. 197 (Comm'r Pat. 1909).

#### PREVIOUS ACTION BY DIFFERENT EXAMINER

Title: CONTAINER FOR DISCARDED SMOKING MATERIALS

Serial Number: 10/602,811

Attorney Docket No.: 2442.001

Full faith and credit should be given to the search and action of a previous examiner unless there is a clear error in the previous action or knowledge of other prior art. In general, an examiner should not take an entirely new approach or attempt to reorient the point of view of a previous examiner, or make a new search in the mere hope of finding something. *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 126 F. Supp. 2d 69, 139, 57 USPQ2d 1449, 1499-50 (D. Mass. 2001).

Because it is unusual to reject a previously allowed claim, the examiner should point out in his or her office action that the claim now being rejected was previously allowed by using Form Paragraph 7.50.

**2. Claims 1, 3-10, and 15-20 stand rejected under 35 USC § 103(a), citing *Garland* in view of *LaFleur*.**

The Office Action states “*Garland* may not specifically disclose an air eliminator that communicates with the space that is between the bag and the container. However, *LaFleur* does not teach that when flexible bags are used to line rigid containers, such liners need to be filled with materials, it is common for the liner to pull away from the container walls which can cause problems.

...Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to have modified the container of *Garland* to include the air elimination system disclosed in *LaFleur* in order to reduce the likelihood of liner failure when used in the container as taught in *LaFleur*.”

The present invention is directed to a container for discarded smoking materials. Discarded smoking materials may be burning or smoldering when discarded into the container. As stated in the specification of the present application, “The air eliminator pulls air that is trapped between the bag and the

Title: CONTAINER FOR DISCARDED SMOKING MATERIALS

Serial Number: 10/602,811

Attorney Docket No.: 2442.001

inner walls of the container. By pulling the bag against the inner walls of the container the bag becomes increasingly flame and puncture resistant." Specification, page 7, lines 14-17.

*Garland* is addressed to a diaper pail. *LaFleur* discloses a tank liner for "tanks and other rigid containers to hold various types of liquids and flowable solids." Column 1, lines 12-14 of *LaFleur*. Neither *LaFleur* nor *Garland* is concerned with a container into which burning objects are discarded. Neither *LaFleur* nor *Garland* provide a structure for pulling a bag or similar object against a side of a container to increase flame resistance of the bag.

A *prima facie* rejection under 35 USC § 103(a) requires the Examiner to set forth a motivation or suggestion found in the prior art to combine the cited references to arrive at the invention as claimed. The suggestion or motivation may not be found in the Applicant's specification. "The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. 'To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.' *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985)." M.P.E.P. §706.02(j).

Title: CONTAINER FOR DISCARDED SMOKING MATERIALS

Serial Number: 10/602,811

Attorney Docket No.: 2442.001

One skilled in the art, designing a container for discarded smoking materials, would not find motivation or a suggestion in the prior art to combine *LaFleur* and *Garland* to arrive at the Applicant's invention as claimed. There is no suggestion in *LaFleur* to pull the bag against an interior portion of the container by means of an air eliminator to increase flame resistance, since *LaFleur* is a device for handling liquids, and is not concerned with retarding flammability or burning.

Further, *LaFleur* desires to "seal off the space between the container and liner from the outside air." Air between the liner and the container is removed and then a seal is formed around the peripheral of the filler opening. The air is "removed by expanding the liner or forcing its bottom side and side wall to lie closely adjacent to the corresponding container walls while permitting the air to escape between the container, filter opening and the liner. The liner may be expanded by supplying a large volume of air at slightly super atmospheric pressure to the interior of the liner by using a blower or fan and preferably a 'leaf blower' typically used for lawn and garden leaf removable." *LaFleur*, Column 2, line 47-55.

The air eliminator of the present invention communicates with the space between the bag and the container to eliminate (which is why this element of the claim is called an air *eliminator*) the air between the bag and the container. *LaFleur* teaches no such air eliminator. *LaFleur*, in fact, introduces air into the

Title: CONTAINER FOR DISCARDED SMOKING MATERIALS

Serial Number: 10/602,811

Attorney Docket No.: 2442.001

container, and does not provide an air eliminator between the liner and the wall of the container.

Claim 3 requires that the air eliminator communicate with the space that is between the lower portion of the bag and the container. The Office Action does not set forth which structure of *LaFleur* is intended to meet the requirement of an air eliminator, or how this air eliminator communicates with the spaces between the lower portion of the bag and the container. “In making such final rejection, the Examiner shall repeat or state all grounds of rejection that seemed applicable to the claims in the application, **clearly stating the reasons in support thereof.**” 37 CFR § 1.113(b); MPEP § 706.07 (emphasis added). “It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply....Since patent examiners cannot normally be compelled to testify in legal proceedings regarding their mental processes..... it is important that the written record clearly explain the rationale for decisions made during prosecution of the application.” M.P.E.P. §706.02(j).

The Office Action fails to clearly state how the cited references meet the the following requirements the claims: an upper portion of a container that is funnel shaped and supports the bag (Claim 4;Claim 15); an upper container that is above the closure mechanism and is funnel shaped (Claim 5; Claim 16); a flame retardant bag (Claim 6; Claim 17); a lower portion of the container that may be *selectively* separated from the upper portion of the container (Claim 7 Claim 18); a lower portion that is below the closure mechanism that may be *selectively* separated from the upper portion of the

Title: CONTAINER FOR DISCARDED SMOKING MATERIALS

Serial Number: 10/602,811

Attorney Docket No.: 2442.001

container (Claim 8); an air eliminator that is a vacuum pump (Claim 9; Claim 19); a closure mechanism is spring biased (Claim 10; Claim 20).

With regard to Claims 6 and 17, the Office Action states that flame retardant material is "a standard characteristic of many arts" but fails to cite a supporting reference, and fails to set forth a motivation of suggestion to combine such flame retardant material with the remainder of the claim elements (such as a closure mechanism that restricts air to the interior of the bag) to arrive at the present invention. M.P.E.P. §706.02(j).

With regard to Claims 10 and 20, the Office Action states that spring biased "closures are conventional in many arts" but fails to cite a supporting reference, and fails to set forth a motivation of suggestion to use a spring biased closure with the remainder of the claim elements. The use of spring biasing insures that the container remains closed if, for example, a cigarette butt is added, so that additional air does not enter the container to encourage flame.

The rejection of the claims under 35 USC § 103(a) is due to be withdrawn.

**3. Claims 13 and 14 stand rejected under 35 USC § 102(b) as being anticipated either by *Krein*, U.S. Patent No. 5,059,084 or *LaFleur*.**

The Office Action fails to repeat or state grounds of rejection applicable to the claims in the application, and the reasons and support of the rejection are not clearly stated. In particular, the Office Action simply states "*Krein* or *LaFleur* discloses all that is recited in the claims." No indication is provided of the elements of the cited references that

Title: CONTAINER FOR DISCARDED SMOKING MATERIALS

Serial Number: 10/602,811

Attorney Docket No.: 2442.001

anticipate the rejected claims. The Office Action fails to meet the requirement of "clearly stating the reasons in support" of the grounds of rejection. 37 CFR § 1.113(b); MPEP § 706.07.

Claim 13 is amended hereby to require that the "air eliminator pulls air from said enclosed space", and that the "bag is sealed against said container at an opening of said container". Claim 13 also requires that when the "bag is in position and sealed against said container, and the ashtray is in use, air does not enter said enclosed space." The seal is provided by the elastic band that is over the bag and the top of the container. See Figure 6 and the Specification at page 7, lines 6-7. *Krein* does not maintain a seal after the liner is in position for use. The present invention uses the seal, and the relative vacuum in the enclosed space to maintain the position of the bag against the container, whereas *Krein* physically attaches the liner to the container when the liner and container are in use. *LaFleur* does not meet the limitations of these Claims.

**4. Claims 13-20 stand rejected under 35 USC § 112, first paragraph.**

The amendment to claim 13 renders this rejection moot.

Title: CONTAINER FOR DISCARDED SMOKING MATERIALS

Serial Number: 10/602,811

Attorney Docket No.: 2442.001

It is respectfully submitted that Claims 1, 3-10 and 13-20 are in condition for allowance. Review and allowance at the earliest possible date are requested.

Respectfully submitted,

  
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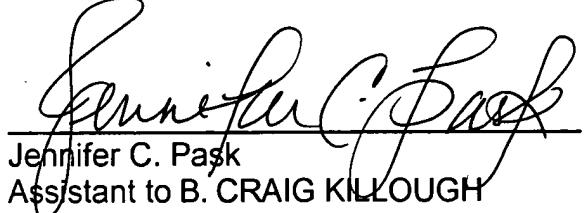


Title: CONTAINER FOR DISCARDED SMOKING MATERIALS  
Serial Number: 10/602,811  
Attorney Docket No.: 2442.001

Dated: March 6, 2006

CERTIFICATE OF MAILING

I hereby certify that this Response to Office Action dated January 5, 2006, and post card, are being deposited with the United States Postal Service, with sufficient postage attached thereto, in an envelope addressed to: MAIL STOP AF, COMMISSIONER FOR PATENTS, P.O. BOX 1450, Alexandria, VA 22313-1450, on this 6th day of March, 2006.

  
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